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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.             | CONFIRMATION NO.            |
|--|-------------|----------------------|---------------------------------|-----------------------------|
| 10/596,264   | 05/25/2007  | Brian Henry Foscett  | 139356WOUS                      | 4676                        |
| 81352  | 7590        | 10/15/2010           |                                 |                             |
| RG and Associates<br>1103 Twin Creeks<br>Allen, TX 75013 |             |                      | EXAMINER<br>ELALLAM, AHMED      |                             |
|  |             |                      | ART UNIT<br>2471                | PAPER NUMBER                |
|  |             |                      | NOTIFICATION DATE<br>10/15/2010 | DELIVERY MODE<br>ELECTRONIC |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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|                              |                                      |                                       |  |
|------------------------------|--------------------------------------|---------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/596,264 | <b>Applicant(s)</b><br>FOSKETT ET AL. |  |
|                              | <b>Examiner</b><br>AHMED ELALLAM     | <b>Art Unit</b><br>2471               |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Objections*

1. Claims 15 and 20 are objected to because of the following informalities:

In claim 15, "at least one media gateway includes" lacks antecedent basis, because a "first media gateway" is already recited. The lack of the antecedent basis cast a doubt to whether there is only one first gateway or more gateways.

Regarding claim 20, claim 20 recites "a second media gateway" and recites also "at least one media gateway"; it is not clear whether the "at least one media gateway" refers to the first media gateway (of independent claim 15) or the second media gateway.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-22 rejected under 35 U.S.C. 102(e) as being anticipated by Rabipour US2004/0004957 A1. Hereinafter referred to as Rabipour.

#### **As to independent claims 1, 9, 15 and 21:**

Regarding claim 1, with reference to figures 2-4, Rabipour discloses method for providing packet-based tandem free operation (TFO) in a telecommunications system

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having a first remote entity (claimed first network element), a second remote entity (claimed third network element), and a gateway positioned between the first remote entity and second remote entity (claimed second network element positioned between the first and third network elements), see paragraph [0022], the method comprising:

The gateway comprising a control entity for monitoring end-to-end connection and for detecting the presence of in-band messages received from the first remote entity, the in-band messages being indicative of an attempt by the first remote entity to enter a tandem-free mode of operation, and in the absence of an in-band response message from the second remote entity, the control entity is operative to generate and send an in-band response message to the first remote entity and negotiate therewith establishment of a second connection with the first remote entity, while maintaining the portion of the end-to-end connection between the gateway and the second remote entity. See paragraph [0022]. (Claimed monitoring packets sent from the first network element to the third network element to identify a TFO request message; monitoring packets sent from the third network element to the first network element to identify a TFO acknowledgement message from the third network element in response to the TFO request message; sending a substitute TFO acknowledgement message from the second network element to the first network element if no TFO acknowledgement message is identified from the third network element; and establishing a TFO call leg between the first and second network elements and establishing a non-TFO call leg between the second and third network elements after sending the substitute TFO acknowledgement message from the second network element).

Regarding claim 9, with reference to figures 2-4, Rabipour discloses method for providing packet-based tandem free operation (TFO) in a telecommunications system having a first remote entity configured for tandem free operation (claimed first device configured for TFO capability), a second remote entity (claimed second device not configured for TFO capability); and a gateway positioned between the first remote entity and second remote entity (claimed first media gateway positioned between a first device second device, see paragraph [0022], the method comprising:

The gateway comprising a control entity for monitoring end-to-end connection and for detecting the presence of in-band messages received from the first remote entity, the in-band messages being indicative of an attempt by the first remote entity to enter a tandem-free mode of operation, and in the absence of an in-band response message from the second remote entity, the control entity is operative to generate and send an in-band response message to the first remote entity and negotiate therewith establishment of a second connection with the first remote entity, while maintaining the portion of the end-to-end connection between the gateway and the second remote entity. See paragraph [0022]. (claimed monitoring packets sent from the first device to the second device to identify a TFO request, wherein the monitoring is performed by the media gateway; monitoring packets sent from the second device to the first device to identify a TFO acknowledgement sent in response to the TFO request, wherein the monitoring is performed by the media gateway; sending a substitute TFO acknowledgement from the media gateway to the first device if no TFO acknowledgement is identified from the second device; and establishing a first leg

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between the first device and the media gateway using TFO and establishing a second leg between the media gateway and second device without using TFO after sending a TFO acknowledgement from the media gateway).

Regarding claim 15, claim 15 is a system claim having the same scope of claim 9, with the additional limitation of the first media gateway being coupled to a BSC having TFO capability, the system being the first media gateway as understood from the specification). Rabipour discloses media gateway in connection with a BSC, see figure 1, and paragraph [0033].

Regarding claim 21, with reference to figures 2-4, Rabipour discloses method for providing packet-based tandem free operation (TFO) in a telecommunications system having a first remote entity (claimed first network element), a second remote entity (claimed third network element), and a gateway positioned between the first remote entity and second remote entity (claimed second network element positioned between the first and third network elements), see paragraph [0022], the method comprising:

The gateway comprising a control entity for monitoring end-to-end connection and for detecting the presence of in-band messages received from the first remote entity, the in-band messages being indicative of an attempt by the first remote entity to enter a tandem-free mode of operation, and in the absence of an in-band response message from the second remote entity, the control entity is operative to generate and send an in-band response message to the first remote entity and negotiate therewith establishment of a second connection with the first remote entity, while maintaining the portion of the end-to-end connection between the gateway and the second remote

entity. See paragraph [0022]. (means for monitoring packets sent from the first network element to the second network element during call setup to identify a TFO request message; means for establishing a non-TFO call if no TFO request message is identified; means for monitoring packets sent from the second network element to the first network element to identify a TFO acknowledgement message; means for sending a substitute TFO acknowledgement message from the third network element to the first network element if no TFO acknowledgement message is identified from the second network element; and means for establishing a TFO call leg between the first and third network elements and establishing a non-TFO call leg between the second and third network elements after sending a TFO acknowledgement message from the third network element). Rabipour also discloses that the gateway also includes a control entity operative to monitor the second connection; detect the presence of TFO messages received from the second remote entity; in the presence of in-band TFO messages received from the second remote entity, establish an end-to-end TFO connection between the first and second remote entities, see paragraph [0024]. (Claimed means for establishing a TFO call between the first and second network entities if a TFO acknowledgement message is identified from the second network element).

**As to dependent claims 2-8, 10-14, 16-20 and 22:**

Regarding claims 2, 10, 17 and 22, Rabipour discloses that after a timeout period, recognizing that the entity connected at the other end is not eTFO-capable, the

gateway 220 can proceed to initiate its own response. See paragraph [0049]. (Claimed determining whether a timeout period has elapsed without identifying the TFO acknowledgement message from the third network element ; and sending the substitute TFO acknowledgement message from the second network element only if the timeout period has elapsed, as in claims 2 and 22, and determining whether a timeout period has elapsed without identifying the TFO acknowledgement from the second device; and sending the TFO acknowledgement from the media gateway only if the timeout period has elapsed, as in claim 10, and determining whether a timeout period has elapsed without identifying the TFO acknowledgement from the network entity; and instructions for sending the TFO acknowledgement from the first media gateway only if the timeout period has elapsed, as in claim 17).

Regarding claim 3, 4, 11 and 12, claims 3 and 11 calls for starting the timeout period after identifying the TFO request message, and claims 4 and 12 calls for setting the timeout period to a predefined period of time prior to starting the timeout period. Rabipour implicitly discloses these features because Rabipour specifies that after a timeout period, recognizing that the entity connected at the other end is not eTFO-capable, the gateway 220 can proceed to initiate its own response. See paragraph [0049]. (Note: The timeout period being initiated when the Gateway receive the TFO request, as discussed above claim 1).

Regarding claim 5, Rabipour discloses the entity between the end devices is a media gateway, see paragraph [0022].



Regarding claim 6, Rabipour discloses that the gateway is equipped with the intelligence to emulate a eTFO-capable entity. See paragraph [0048], (see also paragraphs [0038] and [0041]). (Claimed the TFO call leg includes the use of enhanced TFO (eTFO)).

Regarding claims 7, 13, and 18, Rabipour discloses in an embodiment that when the gateway is connected to a non-eTFO-capable entity, wherein the gateway recognizes the other end is not eTFO-capable, the coding and decoding is shifted to the gateway instead of the TRAU. See paragraphs [0048]-[0049]. (Claimed establishing a non-TFO call if no TFO request message is identified).

Regarding claims 8, 14, and 19, Rabipour discloses that the gateway, including an interface for allowing establishment of a first connection to a first remote entity and a second connection to a second remote entity, the first connection being a TFO connection. The gateway also includes a control entity operative to monitor the second connection; detect the presence of TFO messages received from the second remote entity; and in the presence of in-band TFO messages received from the second remote entity, establish an end-to-end TFO connection between the first and second remote entities. See paragraph [0024]. (Claimed establishing an end-to-end TFO call if a TFO acknowledgement message is identified from the third network element, as in claim 8; and establishing an end-to-end TFO call if the substitute TFO acknowledgement is identified from the network entity, as in claims 14 and 19).

Regarding claim 16, with reference to figure 5, Rabipour discloses a Mobile Switching Center 520 connected to gateway 530. (Claimed system further comprising at least a first mobile switching center coupled to the first media gateway.

Regarding claim 20, with reference to figure 2, Rabipour shows a first gateway (control entity with TRAU 12), (the first gateway correspond to the claimed at least one media gateway) and a second gateway 220 between the first gateway and the network 240. Rabipour also discloses the second gateway being connected to a non-eTFO-capable entity and is equipped with the intelligence to emulate a eTFO-capable entity, TRAU 12 proceeds to send TFO setup information in an attempt to communicate with a remote entity 260 via a gateway 220, The gateway 220 monitors the messages but, in anticipation of a response from remote entity 260, it does not respond, see paragraph [0048]. Additionally, Rabipour discloses that after a timeout period, recognizing that the entity connected at the other end is not eTFO-capable, the gateway 220 can proceed to initiate its own response, with the ensuing handshaking resulting in the transmission of TFO speech information through a packet-switched communication path 250 established through the network 240, see paragraph [0049]. . (Claimed second media gateway positioned between the first media gateway and the network entity; monitoring packets sent from the first media gateway to the network entity to identify a TFO request; monitoring packets sent from the network entity to the first media gateway to identify a TFO acknowledgement; sending a substitute TFO acknowledgement from the second media gateway to the first media gateway if no TFO acknowledgement is identified from the network entity; and establishing a first leg between the first and

second media gateways using TFO and establishing a second leg between the second media gateway and the network entity without using TFO after sending a TFO acknowledgement from the second media gateway).

### ***Response to Arguments***

1. Applicant's arguments filed on 07/22/2010 have been fully considered but they are not persuasive.

#### **Claims 1 and 9:**

Applicants argue that Rabipour does not describe or suggest all the element of claim 1. Applicants in particular alleged that Rabipour does not disclose

*"monitoring packets sent from the first network element to the third network element to identify a TFO request message; monitoring packets sent from the third network element to the first network element to identify a TFO acknowledgement message from the third network element in response to the TFO request message; sending a substitute TFO acknowledgement message from the second network element to the first network element if no TFO acknowledgement message is identified from the third network element; and establishing a TFO call leg between the first and second network elements and establishing a non-TFO call leg between the second and third network elements after sending the substitute TFO acknowledgement message from the second network element".* Emphasis added.

Examiner respectfully disagrees, Dobbs discloses with reference to figures 2-4, a method for providing packet-based tandem free operation (TFO) in a telecommunications system having a **first remote entity** (claimed first network element), a **second remote entity** (claimed third network element), and a **gateway** positioned between the first remote entity and second remote entity (the **gateway** correspond to the claimed **second network element** that is positioned between the first and third network elements), see paragraph [0022], the method comprising:

The gateway comprising a control entity for **monitoring end-to-end connection** and for **detecting** the presence of **in-band messages** received from the first remote entity, (Claimed *monitoring packets sent from the first network element to the third network element to identify a TFO request message*).

Dobbs specifies that the in-band messages being indicative of an attempt by the first remote entity to enter a tandem-free mode of operation, and **in the absence of an in-band response message from the second remote entity**, the control entity (which is in the **gateway**) is operative to **generate** and **send an in-band response message to the first remote entity** (this clearly correspond to the claimed **substitute TFO acknowledgement**), because the generation of the in-band response is at the gateway in response to lack of receiving a response from the remote entity), the control entity (at the gateway) afterwards negotiate therewith establishment of a **second connection** with the first remote entity, while maintaining the portion of the **end-to-end connection** between the gateway and the second remote entity. See paragraph [0022].

It should be noted that the goal of the Dobbs is for providing packet-based tandem free operation (TFO) between the first entity and the second entity, the end-to-end connection during the signaling phase implies that it is not known a priori that the connection between the gateway and the remote second entity is known of being capable of TFO, The absence of the response from the second remote entity is an indication of the connection between the gateway and the second remote entity not being a TFO connection, thus the gateway generate a response "on-behalf" of the second remote entity, and that is not a direct acknowledgement but a "substitute" acknowledgement.

Examiner concludes that the difference between the claimed invention and the teaching of Dobbs is no more than a lexicographer matter. The in-band generation of the response message by the gateway is exactly the same as the "substitute" TFO acknowledgment. Therefore, the alleged "teaching away" of Dobbs by the Applicants does not have merits further Applicant did not give any details of what Dobbs does to teach away with regard to the claimed invention.

Given the above, and contrary to Applicants' argument, Dobbs clearly anticipate the invention of claim 1.

**Independent claims 9, 15, and 21 and dependent claims 2-8, 10-14, and 16-20:**

Applicants stated that independent claims have similar limitations as in claim 1, and dependent claims should be allowed since they depend from allowable independent

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claims. Examiner respectfully disagrees for the reason stated above with regard to independent claim 1.

Examiner inadvertently indicated the rejected claims under 103 title, Applicants neither addressed this minor error. Since the rejections of the claims are maintained on the merit, the finality of this office action is believed to be proper under the anticipation.

### ***Conclusion***

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AHMED ELALLAM whose telephone number is (571)272-3097. The examiner can normally be reached on 7-5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi H. Pham can be reached on (571) 272-3179. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/AHMED ELALLAM/  
Examiner, Art Unit 2471  
10/8/10

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